

2FW

PATENT CASE: OC06001-01



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Timothy J. Guzi et al.

Examiner: To Be Assigned

Serial No.: **10/735,983**

Group Art Unit: Unknown

Filed: **12/15/2003**

Date: June 30, 2004

For: **"17 β -Hydroxysteroid
Dehydrogenase Type 3 Inhibitors
for the Treatment of Androgen
Dependent Diseases"**

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT
SUBMISSION OF INTERNATIONAL SEARCH REPORT

Sir:

It is requested that the following documents cited in the International Search Report and in the accompanying form PTO-1449, be considered and made of record.

Patents cited in the International Search Report:

US 6,362,188 (attached)
EP 1,122,242 (attached)
WO 03/022835 (attached)
WO 03/033487 (attached)
WO 99/46279 (attached)

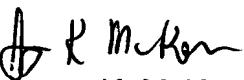
Additional References Submitted:

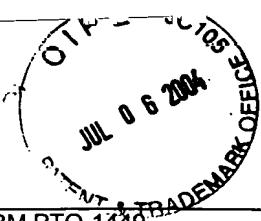
| | |
|-------------|----------------|
| WO 86/01105 | WO 96/26201 |
| WO 90/10462 | WO 97/11162 |
| WO 91/00731 | WO 99/46279 |
| WO 91/00733 | WO 2004/046111 |
| WO 94/26767 | |

The submission of these documents is not to be presumed as an admission that these documents are prior art. The documents are being furnished solely for their possible utility in the examination of the present case. Since no Office Action has issued on the merits of this case, Applicants believe that no fee is due at this time. If, however, any fees are due, the Office may charge such fees to Deposit Account No. 19-0365. If the Examiner has any questions, the Examiner is invited to contact the undersigned.

June 30, 2004
Schering-Plough Corporation
2000 Galloping Hill Road
Patent Department, K-6-1,1990
Kenilworth, NJ 07033
Tel: (908) 298-2135
Fax: (908) 298-5388

Respectfully submitted,


Jeremy K. McKown
Attorney for Applicants
Reg. No. 47,785



Sheet 1 of 1

| FORM PTO-1449 | | U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE | | ATTY. DOCKET NO.: OC06001US01 | APPLICATION NO.: 10/735,983 | | |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------|------------------------------------------------------------|-------------------|---------------------------------------------|---------------------------------------|-----------|----------------------------|
| INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use several sheets if necessary)</i> | | | | APPLICANT: Timothy J. Guzi et al. | | | |
| | | | | FILING DATE: 12/15/2003 | GROUP: | | |
| U.S. PATENT DOCUMENTS | | | | | | | |
| *EXAMINER INITIAL | | DOCUMENT NUMBER | DATE | NAME | CLASS | SUB-CLASS | FILING DATE IF APPROPRIATE |
| AA | | US 6362188 | 03/26/2002 | Guzi et al. | | | |
| AB | | | | | | | |
| AC | | | | | | | |
| AD | | | | | | | |
| AE | | | | | | | |
| AF | | | | | | | |
| AG | | | | | | | |
| AH | | | | | | | |
| AI | | | | | | | |
| AJ | | | | | | | |
| AK | | | | | | | |
| FOREIGN PATENT DOCUMENTS | | | | | | | |
| | | DOCUMENT NUMBER | DATE | COUNTRY | CLASS | SUB-CLASS | TRANSLATION |
| AL | | EP 1122242 | 08/08/2001 | Europe | | | |
| AM | | WO 03/022835 | 03/20/2003 | PCT | | | |
| AN | | WO 03/033487 | 04/24/2003 | PCT | | | |
| AO | | WO 9946279 | 09/16/1999 | PCT | | | |
| AP | | WO 86/01105 | 02/27/1986 | PCT | | | |
| AQ | | WO 90/10462 | 09/20/1990 | PCT | | | |
| AR | | WO 91/00731 | 01/24/1991 | PCT | | | |
| AS | | WO 91/00733 | 01/24/1991 | PCT | | | |
| AT | | WO 94/26767 | 11/24/1994 | PCT | | | |
| AU | | WO 96/26201 | 08/29/1996 | PCT | | | |
| AV | | WO 97/11162 | 03/27/1997 | PCT | | | |
| AW | | WO 99/46279 | 09/16/1999 | PCT | | | |
| AX | | WO 2004/046111 | 06/03/2004 | PCT | | | |
| AY | | | | | | | |
| OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.) | | | | | | | |
| AZ | Copy of International Search Report for OC06001-01 (7pgs.) | | | | | | |
| BA | | | | | | | |
| BB | | | | | | | |
| BC | | | | | | | |
| BC | | | | | | | |
| BD | | | | | | | |
| EXAMINER | | | | DATE CONSIDERED | | | |
| <p>*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.</p> | | | | | | | |



Copy

Sheet 1 of 1

| FORM PTO-1449 | | U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE | | ATTY. DOCKET NO.: OC06001US01 | APPLICATION NO.: 10/735,983 | | |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------|------------------------------------------------------------|--------------------|---------------------------------------------|---------------------------------------|----------------------------|----|
| INFORMATION DISCLOSURE STATEMENT BY APPLICANT | | | | APPLICANT: Timothy J. Guzi et al. | | | |
| (Use several sheets if necessary) | | | | FILING DATE: 12/15/2003 | GROUP: | | |
| U.S. PATENT DOCUMENTS | | | | | | | |
| *EXAMINER INITIAL | DOCUMENT NUMBER | DATE | NAME | CLASS | SUB-CLASS | FILING DATE IF APPROPRIATE | |
| AA | US 6362188 | 03/26/2002 | Guzi et al. | | | | |
| AB | | | | | | | |
| AC | | | | | | | |
| AD | | | | | | | |
| AE | | | | | | | |
| AF | | | | | | | |
| AG | | | | | | | |
| AH | | | | | | | |
| AI | | | | | | | |
| AJ | | | | | | | |
| AK | | | | | | | |
| FOREIGN PATENT DOCUMENTS | | | | | | | |
| | DOCUMENT NUMBER | DATE | COUNTRY | CLASS | SUB-CLASS | TRANSLATION | |
| AL | EP 1122242 | 08/08/2001 | Europe | | | YES | NO |
| AM | WO 03/022835 | 03/20/2003 | PCT | | | | |
| AN | WO 03/033487 | 04/24/2003 | PCT | | | | |
| AO | WO 9946279 | 09/16/1999 | PCT | | | | |
| AP | WO 86/01105 | 02/27/1986 | PCT | | | | |
| AQ | WO 90/10462 | 09/20/1990 | PCT | | | | |
| AR | WO 91/00731 | 01/24/1991 | PCT | | | | |
| AS | WO 91/00733 | 01/24/1991 | PCT | | | | |
| AT | WO 94/26767 | 11/24/1994 | PCT | | | | |
| AU | WO 96/26201 | 08/29/1996 | PCT | | | | |
| AV | WO 97/11162 | 03/27/1997 | PCT | | | | |
| AW | WO 99/46279 | 09/16/1999 | PCT | | | | |
| AX | WO 2004/046111 | 06/03/2004 | PCT | | | | |
| AY | | | | | | | |
| OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.) | | | | | | | |
| AZ | Copy of International Search Report for OC06001-01 (7pgs.) | | | | | | |
| BA | | | | | | | |
| BB | | | | | | | |
| BC | | | | | | | |
| BC | | | | | | | |
| BD | | | | | | | |
| EXAMINER | | | | DATE CONSIDERED | | | |
| <p>*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.</p> | | | | | | | |

Application No.: 10/735,983

Filing Date: 12/15/2003

Applicant: Timothy J. Guzi et al.

Title: "17beta-Hydroxysteroid Dehydrogenase Type 3 Inhibitors for the Treatment of Androgen Dependent Diseases"



Certificate of Mailing under 37 CFR 1.8

Thereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on 06/30/2004
Date

A handwritten signature in black ink, appearing to read "J. K. McKown".

Signature

Jeremy K. McKown, Reg. No. 47,785

Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

Documents enclosed:

Certificate of Mailing - 1pg.

Supplemental Information Disclosure Statement - 2pgs.

PTO-1449 Form - 1pg. in duplicate

References (14)

Copy of International Search Report - 7pgs.

Post Card

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.